

F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989). Thus, there is no need for Strobel to make clear how different hardnesses result from different processing conditions. Nor is it necessary for Strobel to show that different processing conditions in the claimed process result in different hardnesses. The only thing that Strobel needs to show is that hardnesses are not inherent and Strobel has satisfied this burden. It is equally well settled that newly discovered properties can be the basis of claims to novel compositions. See *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1340, 1345, 7 USPQ2d 1129, 1133 (Fed. Cir. 1988), cert. Denied, 109 S. Ct. 542 (1988).

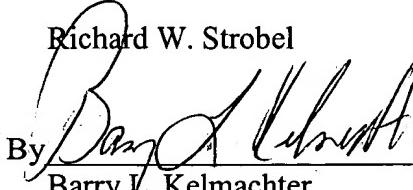
With respect to the Examiner's comments about the Arai patents, the Examiner misses one key point – namely, the claims call for non-electroplated coatings and Arai's patents only teach the production of electroplated coatings. Arai does not teach or suggest how to form non-electroplated coatings having the claimed compositions and the claimed hardnesses. Thus, it cannot teach or suggest the claimed invention. Further, Arai never says that he reflows any of his coatings. Even if he did, they are electroplated coatings – something excluded by the claims.

As to the Brinkmann patent, Applicant has shown exactly what the Examiner requested him to show during the interview – namely, take the Brinkmann composition closest to Applicant's and show that phosphorous has a deleterious effect on hardness. As a bonus, Applicant also demonstrated that Brinkmann's composition does not have a hardness in the claimed range. The Examiner misses the key point of this test – namely, that hardness is not inherent in composition. Brinkmann simply does not teach or suggest how one can obtain the claimed coatings with the claimed hardnesses. If the Examiner believes that Brinkmann teaches this, then he should clearly explain where this teaching lies in the reference because Applicant does not believe it is there.

It is submitted that Applicant has met its burden of showing a novel, unobvious and useful coating having novel hardness properties and that the Examiner has failed to sustain his burden of showing prior art which anticipates or renders the claimed invention obvious.

Respectfully submitted,

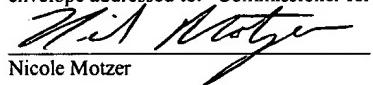
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on September 22, 2003.


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